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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,878	08/10/2006	Michel Bosshardt	007035.00026	7387

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EXAMINER

MAZUMDAR, SONYA

ART UNIT	PAPER NUMBER
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1791

MAIL DATE	DELIVERY MODE
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09/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,878	Applicant(s) BOSSHARDT, MICHEL	
	Examiner SONYA MAZUMDAR	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-65 is/are pending in the application.
- 4a) Of the above claim(s) 48-51, 59 and 63-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-47, 52-58 and 60-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/10/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of invention I, claims 30-47 and 52-62, in the reply filed on July 14, 2009 is acknowledged. The traversal is on the grounds that with newly amended claim 48 drawn to an apparatus, the search would not cause unnecessary burden on the Examiner. However, this is not found persuasive because the specifics to examine a process, namely the stepwise claim limitations and the material (e.g. cylindrical walls and bodies of containers) undergoing a change in physical or chemical state, are not required when examining an apparatus, which is limited only by structural limitations. Although a process claim may contain apparatus limitations, they are only given patentable weight as to how the structure affects the stepwise process. Similarly, the specifics of an apparatus do not require the same consideration of stepwise process limitations as in a process claim but rather only that the structure is capable of performing such process step.

2. Claim 59 was inadvertently left out of the claims classified in invention II, but is also withdrawn from consideration, as it is a dependant claim of claim 48.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. Claims 30 and 53 are objected to because of the following informalities: In line 19 of claim 30, "transferable" should be changed to "transfer". In line 8 of claim 53, "the cylindrical container wall" should be changed to "the cylindrical wall".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 30-47, 52-58, and 60-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 30 and 52 disclose "a transfer film bearing strip"; however the dependant claims refer to "the transfer film" and "the bearing strip". One phrase should be chosen to maintain consistency throughout the claims to properly understand the claimed inventions.

7. Claim 30 recites the limitation "the container unit" in line 24. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 37 recites the limitation "the marking area" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 39 recites the limitation "the contact generatrix line" in line 3. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 40 recites the limitation "the cylindrical body" in line 1. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 47 recites the limitation "the device" in line 1. There is insufficient antecedent basis for this limitation in the claim. Furthermore, claims 30, 31, 46, and 47 do not disclose a "first optical device" complemented with the "second optical device".

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12. Claim 52 recites the limitation "the container unit" in line 32. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 55 recites the limitation "the sleeve" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 30, 35, 36, 37, 38, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiwek (US 6,531,018).

With respect to claims 30, 35, 36, and 56, Fiwek teaches a process for decorating the cylindrical wall of a plurality of containers comprising:

a) mounting a plurality of moving mandrels (22) on a loop circuit, each mandrel being mounted on a support (4) capable of moving such that the axis of the mandrel remains parallel to a given direction, and able to rotate around its axis while resisting a force exerted perpendicular to the axis;

b) successively bringing each of the containers (1) flush with one of the plurality of mandrels and fitting the container onto the mandrel by controlling a drive unit to secure the container (column 2, lines 45-47);

c) bringing the mandrel into the vicinity of an impression roll (11) driven in a continuous rotary motion around a fixed axis;

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d) rotating the mandrel around its axis while it is being moved towards the impression roll,

e) running a transfer film (10) between the impression roll and the mandrel covered with the container at a linear velocity equal to the tangential velocities of the roll and container (column 1, lines 53-67);

f) bringing the mandrel and the impression roll into contact with each other, the cylindrical wall of the container and the surface of the impression roll being driven at a substantially equal tangential velocity, the contact translating into a force exerted by the impression roll on the mandrel through the transfer film and the wall of the container (column 2, lines 57-60; column 6, lines 35-40);

g) moving the transfer film away from the surface of the container, with the result that the part of the transfer film remaining bonded to the container wall is detached from the transfer film, to decorate the container;

h) moving the mandrel and container away from the impression roll to leave room for the next mandrel (abstract; Figure 1).

With respect to claim 37, Fiwek teaches that a mandrel is made to rotate such that it is able to reach the appropriate velocity before it reaches the location where the container is printed upon (column 2, lines 5-6).

With respect to claim 38, Fiwek teaches rotating an impression roll at a constant speed (column 1, lines 54-56).

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Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 52 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiwek in view of Robertson et al. (US 4,175,993) and Eder (US 5,464,495).

Fiwek teaches a process for decorating the cylindrical walls of a plurality of containers comprising:

a) mounting a plurality of moving mandrels (22) on a loop circuit, each mandrel being mounted on a support (4) capable of moving such that the axis of the mandrel remains parallel to a given direction, and able to rotate around its axis while resisting a force exerted perpendicular to the axis;

b) successively bringing each of the containers (1) flush with one of the plurality of mandrels and fitting the container onto the mandrel by controlling a drive unit to secure the container (column 2, lines 45-47);

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c) bringing the mandrel into the vicinity of an impression roll (11) driven in a continuous rotary motion around a fixed axis;

d) rotating the mandrel around its axis while it is being moved towards the impression roll,

e) running a transfer film (10) between the impression roll and the mandrel covered with the container at a linear velocity equal to the tangential velocities of the roll and container (column 1, lines 53-67);

f) bringing the mandrel and the impression roll into contact with each other, the cylindrical wall of the container and the surface of the impression roll being driven at a substantially equal tangential velocity, the contact translating into a force exerted by the impression roll on the mandrel through the transfer film and the wall of the container (column 2, lines 57-60; column 6, lines 35-40);

g) moving the transfer film away from the surface of the container, with the result that the part of the transfer film remaining bonded to the container wall is detached from the transfer film, to decorate the container;

h) moving the mandrel and container away from the impression roll to leave room for the next mandrel (abstract; Figure 1).

Fiwek does not teach providing a mandrel having a diameter slightly less than the diameter of the cylindrical wall of the container. However, Robertson et al. teach providing a transport wheel (37) comprising cylindrical bottle mounting means (41) with bottle gripping hands (43a, 43b) that are adjustable according to the dimension of the bottle and are normally maintained in a closed position (column 4, lines 41-66; column

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16, lines 48-55; Figure 5). Therefore, it would have been obvious to one having ordinary skill in the art to provide mandrels, where the diameters may be adjustable, to allow gripping of bottles or containers for placement onto a mandrel when necessary.

Fiwek also does not teach coating an adhesive onto the wall of a container before applying decoration(s) thereon. However, Eder teaches applying adhesive through an applicator (12) directly onto passing containers (1) rotating on a conveyor, which applies adhesive, preferably hot adhesive. It would have been obvious to one having ordinary skill in the art to do so to limit the amounts of adhesive used, since when hot melt adhesive is used, it is only necessary to apply adhesive to a few points to the leading edge of the label to hold it in place (column 4, lines 56-67).

19. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fiwek as applied to claim 56 above, and further in view of Fiwek (US 6,098,689).

The teachings of claim 56 are as described above.

Fiwek ('018) does not specifically teach using an electric motor to operate an impression roll. However, it would have been obvious to one having ordinary skill in the art to do so, as Fiwek ('689) teaches using electric motors in carrying out the process because it is difficult to coordinate the large number of individual movements of different means and this coordination of the individual movements can only be accomplished with the help of implementing electric motors (column 1, lines 59-67).

20. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fiwek as applied to claim 30 above, and further in view of Eder.

The teachings of claim 30 are as described above.

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Fiwek also does not teach coating an adhesive onto the wall of a container before applying decoration(s) thereon. However, Eder teaches applying adhesive through an applicator (12) directly onto passing containers (1) rotating on a conveyor, which applies adhesive, preferably hot adhesive. It would have been obvious to one having ordinary skill in the art to do so to limit the amounts of adhesive used, since when hot melt adhesive is used, it is only necessary to apply adhesive to a few points to the leading edge of the label to hold it in place (column 4, lines 56-67).

Allowable Subject Matter

21. Claims 31-34, 39-47, 53-55, and 60-62 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

With respect to claim 31 and its dependant claims, the prior art does not teach or suggest decorating a cylindrical wall of a container by running a transfer film on an impression roller, which is a marking roller with an etched surface, to contact the cylindrical wall of a container and thus decorate the container.

With respect to claim 53-55, the prior art does not teach printing a cylindrical wall of each container in accordance with the required decoration with an ink or varnish promoting the rejection of the transfer film and that, when the mandrel and the impression roll are brought into contact with each other, the contact translates into a force exerted by the impression roll on the mandrel through the transfer film and the cylindrical wall of the container, the force causing the compression of the transfer film,

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translating into an adhesion of a part of the transfer film to the unprinted part of the cylindrical container wall.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SONYA MAZUMDAR whose telephone number is (571)272-6019. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791